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REMARKS

In the final office action dated October 23, 2006, claims 1-8 and 20-23 stand rejected under 35 USC 102(b) as being anticipated by Densert et al (US 6,159,171) (hereinafter DENSERT). Applicant respectfully submits that the office action fails to establish a prima facie case of anticipation under 35 USC 102, and therefore the rejections of claims 1-8 and 20-23 are improper and without permissible basis.

The office action asserts that DENSERT anticipates applicant's indicated limitation in that DENSERT "discloses a head stabilized medical device (1), comprising: a stabilized head-dependent wearable frame structure (2) as best seen in Figures 1 and 2", (office action, page 2, section 4). However, "[a] claim is anticipated only if each and every element as set forth in the claim is found, *either expressly or inherently* described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of CA*, 814 F.2d 628, 631, 2 USPQQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131 (emphasis provided).

Regarding independent claim 1, DENSERT completely fails to disclose at least the limitation of a "head-wearable frame structure *adapted for wearing on a subject's head in a condition thereon of relative positional stability*" recited in applicant's independent claim 1. First, without admitting that the 'housing 2' of DENSERT constitutes a "frame" as recited in applicant's independent claim 1, applicant points out that DENSERT fails to *expressly* describe, depict, or claim that the asserted 'frame' (housing 2) of DENSERT is head-wearable. Second, DENSERT further fails to *expressly* disclose that 'housing 2' is "adapted for wearing on a subject's head *in a condition thereon of relative positional stability*" (emphasis provided). Such express teaching simply does not exist in DENSERT. For this reason, DENSERT fails to *expressly* anticipate at least this limitation of applicant's independent claim 1 under the first prong of the *Verdegaal* test.

Therefore, DENSERT can only establish a prima facie case of anticipation under 35 USC 102(b) by *inherently* disclosing applicant's recited limitations.

"The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic". *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); MPEP § 2112(IV). (emphasis original). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized

by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Roberson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990); MPEP § 2112(IV), (emphasis in original).

The examiner has provided no basis in fact and/or technical reasoning to reasonably support the assertion that the asserted 'frame' (housing 2) of DENSERT (Figs. 1 and 2) is necessarily either "head-wearable", or "adapted for wearing on a subject's head in a condition thereon of relative positional stability". Applicant respectfully submits that simply because the 'nozzle means 25 is inserted into the auditory tube of the ear 32', it does not "necessarily flow" from the teachings that the nozzle can or will provide 'relative positional stability' to 'housing 2'. Rather, although not described or otherwise disclosed in DENSERT, one of ordinary skill in the art would recognize that housing 2 could be mounted in the manner of any of myriad other pieces of analytical equipment as found in doctors' offices and diagnostic rooms of hospitals and clinics. Therefore, it is not necessarily a "head-wearable frame structure adapted for wearing on a subject's head in a condition thereon of relative positional stability" as recited in independent claim 1.

Neither the office action nor the reference itself "make clear that the missing descriptive matter is necessarily present in the thing described in the reference", nor that it "necessarily flows from the teachings of the applied prior art". The required inherency "may not be established by probabilities or possibilities" alone. Therefore, even if said frame structure could possibly be worn on the head, which applicant does not concede, that possibility alone is insufficient to establish inherency.

For at least the reasons that DENSERT fails to either expressly or inherently disclose at least the limitations of a "head-wearable frame structure *adapted for wearing on a subject's head in a condition thereon of relative positional stability*", as recited in applicant's independent claim 1, applicant respectfully submits that DENSERT fails to provide basis for a proper rejection of independent claim 1 under 35 USC 102(b). Therefore, applicant submits that claim 1 is allowable as amended in the August 17, 2006 response, and requests the examiner to withdraw the rejection from claim 1. Further, inasmuch as rejected claims 2-6 depend from and include the patentably distinguishable limitations of independent claim 1,

applicant also submits that claims 2-6 are likewise allowable, and also requests withdrawal of the 35 USC 102(b) rejections from claims 2-6.

Regarding independent claim 7, the same arguments apply as presented above with regard to independent claim 1. Further, not only does DENSERT completely fail to expressly or inherently disclose that 'housing 2' is a "frame structure wearably securable to a subject's head", but in particular, DENSERT fails to disclose that such housing can be secured "in a manner causing the frame structure to function as a non-relative-motion unit with the head", as recited in applicant's independent claim 7. Applicant does not admit that the 'housing 2' of DENSERT constitutes a "frame" as recited in applicant's independent claim 7.

DENSERT expressly describes a "hose 24" interposed between 'nozzle means 25' and 'housing 2'. The plain meaning of "hose", as understood at and prior to the time applicant's application was filed, and consistent with the figures and description of DENSERT, is a "flexible tube for conveying liquids or gases under pressure", (Webster's II New Riverside University Dictionary, (Houghton Mifflin Company, 1988) (emphasis supplied). Therefore, DENSERT expressly discloses a flexible element interposed between the 'housing 2' and the 'nozzle 25', potential allowing 'nozzle means 25' and 'housing 2' to move somewhat independently from each other. Because the 'nozzle means 25' is the only element in DENSERT described as contacting a human being, the presence of the flexible 'hose 24' interposed between 'housing 2' and 'nozzle means 25' implicitly teaches away from 'housing 2' functioning "as a non-relative-motion unit" relative to a subject's head. Rather, any motion of the 'housing 2' will almost necessarily will be motion relative to the subjects head.

DENSERT does not describe, and the office action does not make clear that the recited limitation(s) in applicant's independent claim 7 is/are necessarily present in the thing described in the reference, nor that it "necessarily flows from the teachings of the applied prior art". The required inherency "may not be established by probabilities or possibilities" alone.

For at least the reasons that DENSERT fails to expressly or inherently disclose at least the limitations of a "frame structure wearably securable to a subject's head in a manner causing the frame structure to function as a non-relative-motion unit with the head", as recited in applicant's independent claim 7, applicant respectfully submits that DENSERT fails to provide basis for a proper rejection of independent claim 7 under 35 USC 102(b). Therefore, applicant submits that claim 7 is allowable as amended in the August 17, 2006

response, and requests the examiner to withdraw the rejection from claim 7. Further, inasmuch as rejected claim 8 depends from and includes the patentably distinguishable limitations of independent claim 1, applicant also submits that claim 8 is likewise allowable, and also requests withdrawal of the 35 USC 102(b) rejection from claim 8.

Regarding independent claim 20, the same arguments apply as presented above with regard to independent claims 1 and 7. DENSERT completely fails, either expressly or inherently, to disclose at least “[a] system . . . comprising headgear worn by a subject, including frame structure seated with positional stability on the subject's head”. DENSERT does not describe, and the office action does not make clear that the recited limitation(s) in applicant's independent claim 20 is/are necessarily present in the thing described in the reference, nor that it “necessarily flows from the teachings of the applied prior art”. The required inherency “may not be established by probabilities or possibilities” alone.

For at least the reasons that DENSERT fails to expressly or inherently disclose at least the limitations of a “[a] system . . . comprising headgear worn by a subject, including frame structure seated with positional stability on the subject's head”, as recited in applicant's independent claim 20, applicant respectfully submits that DENSERT fails to provide basis for a proper rejection of independent claim 20 under 35 USC 102(b). Therefore, applicant submits that claim 20 is allowable as originally presented, and requests the examiner to withdraw the rejection from claim 20. Further, inasmuch as rejected claims 21-23 depend from and include the patentably distinguishable limitations of independent claim 20, applicant also submits that claims 21-23 are likewise allowable, and also requests withdrawal of the 35 USC 102(b) rejections from claims 21-23.

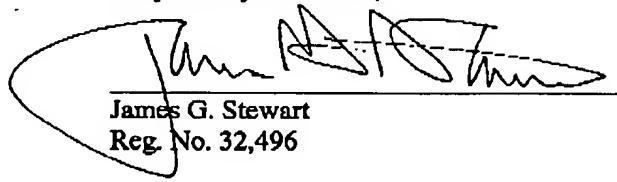
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CONCLUSION

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Accordingly, applicant respectfully submits that all claims are allowable as originally or previously presented, or as amended in applicant's response submitted August 17, 2006. The Examiner is encouraged to telephone the undersigned at (503) 984-2824 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,



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